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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,288	03/01/2002	Robert C. Mayes	10014732-1	2038

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

WU, RUTAO

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/086,288	MAYES ET AL.	
	Examiner	Art Unit	
	Rutao Wu	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. In response filed April 20, 2006 the applicant amended claim 18 and cancelled claims 19 and 20. No new claims have been introduced. Claims 1-18 are currently pending in the application.

Response to Arguments

2. Applicant's arguments, see page 6, filed April 20, 2006, with respect to claims 19 and 20 have been fully considered and are persuasive. The U.S.C. § 112 rejection of claims 19 and 20 has been withdrawn.

3. Applicant's arguments, see page 6, filed April 20, 2006, with respect to claim 18 have been fully considered and are persuasive. The U.S.C. §101 rejection of claim 18 has been withdrawn.

4. Applicant's arguments filed April 20, 2006, with respect to claims 1-18 have been fully considered but they are not persuasive.

As per claim the applicant argues that Pierce does not teach the following:

"a first mail system configured to receive a mail piece addressed to an entity and including postage indicia indicating an initial value, determine a cost for delivering the mail piece to the entity, modify the postage indicia to indicate a remaining value wherein the remaining value indicates the initial value reduced by the cost for delivering the mail piece, and transfer the mail piece; and

a second mail system configured to receive the postage indicia indicating the remaining value, process the postage indicia to determine the remaining value of the postage indicia, and indicate the remaining value of the postage indicia.”

The Examiner respectfully disagrees.

Pierce et al disclose a data center 200, which is maintained and operated by an authorized postage meter manufacture or some other authorized agency with and is connected to a postage metering system 10a (col 3: lines 38-40, 56-57), receiving a mailing which includes the recipient's address and debit the user account for the postage and the desired payment to an entity. (col 5: lines 41-50) Therefore, data center 200 in connection with postage metering system 10a is a mail system that determines a cost for delivering a mailing to an entity (postage value) and modifies the postage indicia to indicate a second value, wherein the second value is the total cost that the data center 200 charges minus the postage value.

The claim limitation presented by the applicant states “*modifying the postage indicia to indicate a remaining value...*” as the limitation currently recites, it is not specific, the limitation does not specify that the modified remaining value has to be part of the postage indicia. As shown in figures 4a and 4b the postage indicia 30 is printed on the envelope showing the postage value and a remaining value 70b which is the initial value without the postage cost. Therefore, Pierce et al teaches modifying the postage indicia to indicate a remaining value. A more specific example of the claim recitation that would specify that the remaining value is part of the postage indicia would

be: *"modify the postage indicia to indicate a remaining value within the postage indicia..."*

Pierce et al disclose that in the case of bill payment, the mail piece is send to the third party (payee) and the payment indication notifies that payment have been paid. (col 6: lines 4-7) For the third party to be able to receive mail pieces it is inherent that a mail system exists to receive and process the incoming mail pieces. Also, when the third party receives the mail piece it sees the remaining value as indicated on the mail piece and processes it to indicate that the remaining value is a payment to a bill. Therefore, Pierce et al teaches *"a second mail system configured to receive the postage indicia indicating the remaining value, process the postage indicia to determine the remaining value of the postage indicia, and indicate the remaining value of the postage indicia."*

Claims 2-10 depend on claim 1 and therefore stand rejected.

Claim 11 recites similar limitations as claim 1 and therefore stands rejected.

As per claim 18, the claim recites *"Postage indicia printed on an item to be shipped, comprising: a first monetary value component designated as compensation for a delivery service; and a second monetary value component designated for a funds transfer."*

The applicant defines postage indicia in the specification as: "postage indicia includes any indication of payment for a delivery to be perform by a delivery service. Examples of postage indicia are text printed on a mail piece, postage stamps, and a

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barcode or other code printed on the mail piece. [0022]" Therefore, the postage indicia can consist of anything printed on a mail piece as long as it includes an indication of payment for delivery. Pierce disclose that postage metering system 10a or 10b is used to obtain and printing postage (col 3: lines 54-55) and postage metering system 10a or 10b is connected to data center 200, which is a postage meter for debiting postage account of the user (col 3: lines 56-58). It is well known in the arts that postage meters are used to print postage indicia on mailing pieces, therefore with reference to the definition provided by the applicant and Figures 4a and 4b presented by Pierce et al (which is printed by postage metering system 10a or 10b), the limitations of claim 18 have been taught.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5, 7-8, 10-15, 17-18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat No. 6,865,558 to Pierce et al.

Referring to claim 1:

A delivery service, comprising:

A first mail system configured to receive a mail piece addressed to an entity and including postage indicia indicating an initial value, determine a cost for delivering the mail piece to the entity, modify the postage indicia to indicate a remaining value wherein the remaining value indicates the initial value reduced by the cost for delivering the mail piece, and transfer the mail piece; and (col 5: lines 48-51)

A second mail system configured to receive the postage indicia indicating the remaining value, process the postage indicia to determine the remaining value of the postage indicia, and indicate the remaining value of the postage indicia. (col 6: lines 4-7)

Referring to claims 2 and 12:

The delivery service of claim 1 wherein the second mail system is further configured to:

Modify the postage indicia indicating the remaining value to cancel the remaining value of the postage indicia. (col 5: lines 48-51)

Referring to claim 3:

The delivery service of claim 1, wherein the second mail system is further configured to:

Compensate the entity for the remaining value of the postage indicia. (col 5: lines 54-57)

Referring to claim 4:

The delivery service of claim 3 wherein the second mail system is further configured to:

Credit an account for the entity based on the remaining value of the postage indicia to compensate the entity. (col 5: lines 54-57)

Referring to claim 5:

The delivery service of claim 3 wherein the second mail system is further configured to:

Transfer funds to a bank account for the entity based on the remaining value of the postage indicia to compensate the entity. (col 5: lines 54-57)

Referring to claim 7:

The delivery service of claim 1 wherein the postage indicia includes anti-counterfeiting content. (col 7: lines 4-13)

Referring to claim 8:

The delivery service of claim 1 wherein the postage indicia comprises text printed on the mail piece. (FIG 4a, 4b; col 4: lines 42-63)

Referring to claim 10:

The delivery service of claim 1 wherein the second mail system comprises a user interface configured to display the remaining value of the postage indicia. (col 5: lines 43-47)

Referring to claim 11:

A method of operating a delivery service, the method comprising:

Receiving a mail piece addressed to an entity and including postage indicia indicating an initial value; (col 5: lines 19-40)

Determining a cost for delivery the mail piece to the entity; (col 5: lines 48-51)

Modifying the postage indicia to indicate a remaining value wherein the remaining value indicates the initial value reduced by the cost for delivery the mail piece; (col 5: lines 48-51)

Delivering the mail piece to the entity; and (col 5: lines 62-64)

Compensating the entity for the remaining value indicated by the postage indicia. (col 5: lines 4-7)

Referring to claim 13:

The method of claim 11 further comprising:

Receiving the postage indicia that indicates the remaining value from the entity prior to compensating the entity. (col 6: lines 4-7)

Referring to claim 14:

The method of claim 11 wherein compensating the entity comprises:

Crediting an account for the entity based on the remaining value of the postage indicia. (col 5: lines 54-57)

Referring to claim 15:

The method of claim 11 wherein compensating the entity comprises:

Transferring funds to a bank account for the entity based on the remaining value of the postage indicia. (col 5: lines 54-57)

Referring to claim 17:

The method of claim 11 wherein the postage indicia includes anti-counterfeiting content. (col 7: lines 4-13)

Referring to claim 18:

Postage indicia, printed on an item to be shipped, comprising:

A first monetary value component designated as compensation for a delivery service; and (Fig 4a, 4b)

A second monetary value component designated for a funds transfer. (Fig 4a, 4b)

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

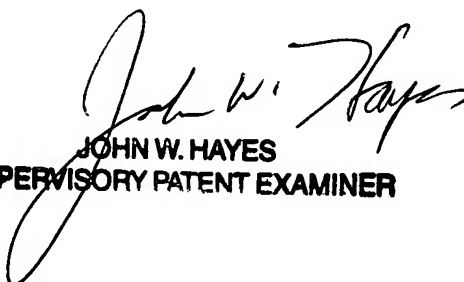
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rutao Wu whose telephone number is (571)272-3136. The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

rw


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER